

REMARKS/ARGUMENTS

Claims 1-7 and 9-16 are active. Claim 8 has been withdrawn from consideration. The claims have been amended for clarity and to emphasize that the glass is selenium-free. According to MPEP 2173.05(i), the current view of the courts is that there is nothing inherently ambiguous or uncertain about such a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph. Here, claim 1 definitely sets forth its boundaries by indicating that the claimed glass is "selenium free". Descriptive support for claim 1 is found in the original claims and on page 4, lines 19-21 of the specification. The drawbacks of prior art glass compositions that contain selenium are disclosed on page 2, line 23 *ff.* of the specification. New claims 15 and 16 find support in original claim 1 and on page No new matter has been introduced.

Restriction/Election

The Applicants previously elected without traverse **Group I**, claims 1-7 and 9-14, directed to gray soda lime silica glass comprising 400-700 ppm NiO. The Applicants respectfully request that the claims of the nonelected group(s) or other withdrawn subject matter which depend from or otherwise include all the limitations of an allowed elected claim, be rejoined upon an indication of allowability for the elected claim, see MPEP 821.04.

Rejection—35 U.S.C. §112, second paragraph

Claim 5 was rejected under 35 U.S.C. 112, second paragraph, as being indefinite. This rejection is moot in view of the amendments above.

Rejection—35 U.S.C. §103(a)

Claims 1-7 and 9-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Krumwiede, et al., U.S. Patent No. 6,274,523. This rejection cannot be sustained because Krumwiede does not disclose or suggest all the elements of the invention, specifically, it is not “free of selenium” as required by independent claim 1. As disclosed in the Krumwiede abstract (line 6), col. 2, lines 56, and claim 1 (col. 11, line 57) the prior art glass composition “uses iron, cobalt and selenium”.

Example 46 in Table 2A of Krumwiede is probably the closest example to the glass of present claim 1 as regards the content of selenium (1 ppm). However, Example 46 clearly differs from claimed coloring combinations:

for the first one, by having a lower content of Fe_2O_3 (0.51%) and NiO (350 ppm) and a higher content of CoO (100 ppm), and

for the second one, by having a lower content of Fe_2O_3 (0.51%), CoO (100 ppm) and NiO (350 ppm).

Consequently, based on Example 46, one of ordinary skill in the art at the time of invention would not have been motivated to suppress selenium and to adjust the contents of Fe_2O_3 , CoO and NiO as required by the invention.

Moreover, Krumwiede indicates that the selenium is an essential ingredient, since “selenium colorant contributes a pink color to the glass as well as a brown color when complexed with iron to form iron selenide (FeSe)” (col. 3, lines 13-15). Krumwiede does not disclose or exemplify all the elements of the invention, namely a selenium-free glass, nor suggest it since it teaches away from the invention by employing selenium as a colorant. As indicated by MPEP 2143.01, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the

teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). In the present situation, elimination of selenium from the prior art glass composition as described in Krumwiede's "Summary of the Invention" as well as in the prior art claims, would change the principle of operation of the prior art glass by modifying its optical characteristics. Accordingly, this rejection cannot be sustained.

Rejection—35 U.S.C. §103(a)

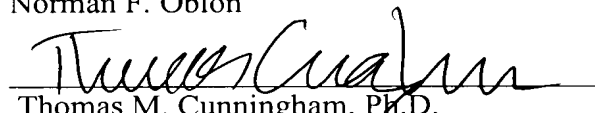
Claims 1-7 and 9-14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Krumwiede, et al., U.S. Patent No. 6,274,523, in view of Stachowiak, U.S. Patent No. 6,475,626. Krumwiede has been addressed above and does not disclose or suggest a selenium-free gray soda-lime silicate glass and teaches away from such a glass by employing selenium as a glass colorant. Stachowiak was relied upon for teaching that grey glasses are used as substrates for coated articles that include having IR (infrared) reflecting layers (OA, page 4, lines 11-12), but does not disclose or suggest what is missing from Krumwiede. Consequently, this rejection cannot be sustained.

Conclusion

This application presents allowable subject matter and the Examiner is respectfully requested to pass it to issue. The Examiner is kindly invited to contact the undersigned should a further discussion of the issues or claims be helpful.

Respectfully submitted,

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